



2833
60,427-218
2000P09005US01

[Handwritten signature]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Karell
Serial No.: 09/844,938
Filed: 04/27/2001
Group Art Unit: 2833
Examiner: Ta, Tho Dac
Title: ELECTRIC CONNECTION FOR FUEL INJECTORS

RESPONSE

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is responsive to the Office Action mailed on May 10, 2004.

Applicant respectfully traverses the rejection under 35 U.S.C. §103 relying upon the improper combination of the *Romann, et al.* reference with the *Murakami* reference. The combination cannot be made.

It is axiomatic that there must be some motivation to combine references in an attempt to establish a *prima facie* case of obviousness. Where there is no benefit to making a combination, there is no motivation and no *prima facie* case of obviousness.

In this instance, there is no benefit to adding the teachings of *Murakami* to the *Romann, et al.* arrangement. As previously discussed, the *Romann, et al.* arrangement includes conductors 5 associated with openings 8 in a printed circuit board. Electrical connections between pins 9 and the conductors 5 are made by receiving the pins through

the openings 8. Then soldering, welding or "solderless squeezing" completes the permanent electrical connection.

There is no benefit to adding the teachings of *Murakami* because the *Romann, et al.* reference already discloses a complete way of making connections. The addition of *Murakami's* teachings would be redundant, at best.

There is no suggestion within the art for making the combination and hindsight reasoning using Applicant's disclosure and claims as a road map for piecing together the prior art is not permissible.

This case has been in condition for allowance for some time. Applicant respectfully requests a Notice of Allowance as soon as possible.

Respectfully submitted,

CARLSON, GASKEY & OLDS

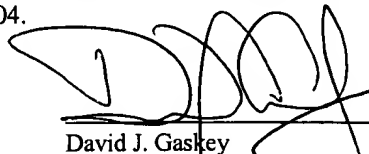
By: 

David J. Gaskey
Registration No. 37,139
400 W. Maple Rd., Ste. 350
Birmingham, MI 48009
(248) 988-8360

Dated: August 10, 2004

CERTIFICATE OF MAILING

I hereby certify that the enclosed Response is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on August 10, 2004.


David J. Gaskey

N:\Clients\SIEMENS\AIR FUEL MODULES\Ip00218\PATENT\Response 8-10-04.doc